

No. 15188

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

LEO MANTIN,

Appellant,

vs.

BROADCAST MUSIC, INC., a corporation, *et al.*,

Appellees.

APPELLEES' ANSWERING BRIEF.

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APPELLEES' ANSWERING BRIEF.

Preface.

This is not a copyright infringement case. It is a diversity case arising under California law complaining of an alleged appropriation from a California citizen of common law intellectual property, namely a musical composition, and the questions to be decided on this appeal are (1) whether or not under the law of California a complaint for the taking of such property is barred by the two year California statute of limitations under the rule announced in *Italiani v. Metro-Goldwyn-Mayer Corp.*, 45 Cal. App. 2d 464, 114 P. 2d 370 (1941), and (2) whether or not, under the law of California plaintiff-appellant has lost all rights in such property by having made the same public. Appellant hereafter is referred to as plaintiff and appellees hereafter are referred to as defendants.

Jurisdictional Statement.

This is an appeal from a judgment of dismissal [R. 48-51] made and entered pursuant to Federal Rules 9(f) and 12(b)(6) in the United States District Court for the Southern District of California, Central Division, Honorable Peirson M. Hall, Judge, decided solely on the ground of the statute of limitations. The judgment followed a motion to dismiss [R. 14-16] bottomed on the propositions *inter alia* (1) that plaintiff's causes of action and each of them, if any, against the defendants, and each of them, are barred by the two year statute of limitations of the state of California, namely by the provisions of California Code of Civil Procedure, Section 339, Subdivision 1, and (2) that it affirmatively appears on the face of the complaint that during the years since plaintiff's alleged composition in 1922 of the musical property here involved he has made the same public under the laws of California, namely Civil Code, Sections 980 and 983, as such sections existed subsequent to 1922 and up to the time of the alleged taking on December 23, 1952.

While for the purposes of the motion to dismiss only, the Court below adjudged that plaintiff had not published his musical composition within the meaning of the law of the state of California [R. 49-50], the defendants may, without taking a cross-appeal, urge in support of the judgment below any ground relied on by them in the Court below, *Gallagher & Speck, Inc. v. Ford Motor Company*, 226 F. 2d 728 (7 Cir., 1955), and defendants do urge in support of said judgment their contention urged below that the face of the complaint shows that plaintiff has made his alleged composition public property.

Jurisdiction below was based upon diversity of citizenship (28 U. S. C., Sec. 1332(a)(1)). The complaint avers that plaintiff is a California citizen [R. 3] and that the defendants are residents and citizens of states other than the state of California [R. 3-5]. The complaint also alleges that the matter in controversy exceeds the sum or value of three thousand dollars (\$3,000.00), exclusive of interest and costs [R. 5].

This Court has appellate jurisdiction, under 28 U. S. C., Sections 1291, 1294(1), to review the final judgment entered against plaintiff. While, following stipulation of counsel, the District Court Judge signed a certificate of finality pursuant to Federal Rule 54(b) [R. 56-57], the certificate would seem to be surplusage because the judgment of dismissal decreed that plaintiff's causes of action, and each of them, are barred by the statute of limitations.

Statement of the Case.

Defendants do not controvert appellant's statement of facts other than as follows: Plaintiff's conclusion that he has never in any form published his composition [Complaint, Par. VI, R. 6], is not consistent with his allegation of the following facts: He is a professional entertainer [Complaint, Par. I, R. 3]. He has sung and performed his composition in night clubs, music halls, theaters, hotels and other places of amusement and entertainment in the United States, England, France and many other countries throughout the world [Complaint, Par. VI, VII, R. 5-6] for more than thirty (30) years, by reason of which thousands of persons in the entertainment industry and hundreds of thousands of persons constituting the general public have attached a secondary

meaning to such composition and its title, identified with plaintiff [Complaint, Par. II, R. 10].

Defendants also desire to point out the following facts:

Incorporated into the complaint by reference and attached thereto as an Exhibit is a copy of defendants' song [Complaint, Par. XII, R. 9, 24-25]. The song in sheet music form shows on its face that its title is "SONG FROM MOULIN ROUGE" with smaller alternate title in parentheses below ("WHERE IS YOUR HEART"), and that it is the song from the picture "Moulin Rouge." The plaintiff alleges that the song incorporated and recorded in the motion picture [Complaint, Par. VIII, R. 7, Par. XII, R. 9] is the "said song" published, recorded and broadcast by the defendants other than the motion picture distributor and producer [Complaint, Par. IX-XII, R. 7-9].

An examination of the lyrics of plaintiff's song [R. 26] with those of defendants' song [R. 25] demonstrates that the only common matter is the phrase "Where Is Your Heart." The record shows that commencing with 1921 (plaintiff composed his song in 1922) there have been at least seven (7) copyright registrations for that title or a variation thereof [R. 35-41] other than the registration covering defendants' song [R. 42-43].

The Complaint does not allege access to plaintiff's composition by defendants in the traditional sense. Instead, in conjunction with the allegation of plaintiff's performance of his song in places of entertainment throughout the world it is alleged merely that defendants have had full knowledge of plaintiff's rights [Complaint, Par. VII, R. 6].

Questions Presented.

Defendants believe that there are two questions to be decided on this appeal:

(1) Where a complaint alleges that on December 23, 1952 certain defendants first released and exhibited and thereafter continuously released and exhibited a motion picture entitled "Moulin Rouge", in which was incorporated and recorded a song entitled "THE SONG FROM MOULIN ROUGE" with an alternate title "WHERE IS YOUR HEART", and which song substantially copied and appropriated the words and music of plaintiff's alleged original song entitled "WHERE IS YOUR HEART", which first date of release and exhibition of such motion picture was more than two (2) years prior to the filing of the complaint, and where other defendants within two (2) years of the filing of the complaint published in sheet music form or recorded on phonograph records or broadcast over the radio *a copy of the song recorded in the motion picture film*, under California law does the two (2) year statute of limitations, Code of Civil Procedure, Section 339, Subdivision 1, apply to forever bar an action against the motion picture producer, the motion picture distributor, the sheet music publisher, the recording companies and the broadcasting companies for appropriation or conversion of plaintiff's alleged common law intellectual property?

(2) Where the complaint shows on its face that plaintiff composed the song in 1922, that thereafter the plaintiff sang and performed his song in night clubs, music halls, theaters, hotels and other places of amusement or entertainment in the United States, England, France and many other countries throughout the world, that by reason of such widespread use, performance and singing

of his song by plaintiff for more than thirty (30) years *thousands of persons in the entertainment industry and hundreds of thousands of persons constituting the general public* have learned to identify plaintiff's song and the title thereof with plaintiff, did such activity over the years constitute a publication under the laws of the state of California, particularly Civil Code, Sections 980 and 983, as they existed between 1922 and the alleged appropriation on December 23, 1952?

Summary of Argument.

A. Statute of Limitations.

When an author chooses not to avail himself of statutory copyright, it is said that he has, under the common law, a property in his intellectual production before it has been published, namely the exclusive right to make the *first publication* of it. It also is said that this common law right of property in an author's intellectual production differs in no respect from any other form of personal property in the protection which the common law places about it. So the author in a proper case may obtain redress against anyone who deprives him of his intellectual property, as by, having improperly obtained it by some means, publishing it or otherwise using it without the author's consent. It is said that this intellectual property is governed by the same rules of transfer and succession and is protected by the same process and has the benefit of all the remedies accorded to other personal property insofar as applicable. And it follows, therefore, as we shall see, that this property must suffer from the same disabilities as other property, for example, the owner's right to sue for its conversion by others may become barred by the statute of limitations.

The common law rights in literary property in California have been codified in Sections 980 and 983 of the California Civil Code. Since this case must be decided under California law, it being a diversity case, and no statutory copyright being involved, any rights which the plaintiff has must be derived from the California code sections cited as they now exist and as they existed during the period in which plaintiff claims to have sung and performed his composition, namely since 1922.

While it is said that an author's common law rights are perpetual, the protection of a perpetual monopoly is contrary to historic American policy. In fact our Federal constitution expressly provides that Congress can only secure for a limited time to an author his copyright to his intellectual production. And although at one time an author's common law rights existed in England, in England today an author's common law rights have been abolished by statute. Congress similarly could abolish common law rights in the United States today, although it has expressly reserved those rights to the author of an unpublished work in our Federal copyright act. Likewise, a state legislature may legislate on the subject of an author's common law rights, even to the point of leaving an author remediless against an appropriator of his common law work.

It follows, therefore, since an author's common law rights in his intellectual production are property and governed generally by the laws of property, a state legislature may enact a specific statute of limitations which would bar any action against an alleged appropriator of an author's literary property after a certain period. Therefore, where the legislature has enacted a compre-

hensive scheme of statutes of limitation applicable to all kinds of actions including those based upon asserted rights in property, tangible or otherwise, the particular statute of limitations found by the courts of that state to be applicable to this species of property may forever bar an action against an alleged appropriator and those who derive their rights from him.

This result flows from the nature of an author's primary right to his unpublished intellectual work. This is the right to *first publish*. If *another first publishes it*, and thereby appropriates it, the wrong is complete and subsequent activity by the appropriator or those who derive their rights from him, adds nothing.

It also follows that if no action may be maintained against the appropriator for the *taking* of the intellectual property because of the bar of the statute of limitations, and, since this particular type of appropriation can be accomplished only by the publication of the intellectual property and the assertion of ownership therein by the appropriator, no action thereafter on account of such publication may be maintained against the appropriator for unfair competition or for an injunction or an accounting. There is but one wrong, an appropriation of intellectual property evidenced by the publication and asserted ownership thereof by another, and as against that other, and those claiming under him, action is barred forever by the statute of limitations.

B. Publication.

Plaintiff characterizes himself as a professional entertainer and composer residing in Los Angeles, California. He composed his song "WHERE IS YOUR HEART" in 1922 and has sung and performed the song in night clubs, music halls, theaters, hotels and other places of amusement and entertainment in the United States, England, France and many other countries throughout the world. By reason of his widespread use, performance and singing of his song for more than thirty (30) years in the places indicated, thousands of persons in the entertainment industry and hundreds of thousands of persons constituting the general public are well acquainted with it.

Plaintiff is a California citizen, the case arises under California law and therefore the question of publication must be decided under that law. In California, as elsewhere, common law rights are limited to unpublished works and all common law property rights in an intellectual production are lost on publication. We assert that the acts of the plaintiff in communicating his song as a professional entertainer to hundreds of thousands of persons of the general public for more than thirty (30) years in hotels, night clubs, theaters and other places of entertainment throughout the United States and the world constitutes a general publication under Section 983 of the California Civil Code and dedicates the work to the public.

This view is strengthened by plaintiff's allegations to the effect that defendants' access to his song was a result of his performance of it throughout the world.

ARGUMENT.

A. A Complaint Filed January 19, 1955 Alleging the Appropriation of Plaintiff's Common Law Intellectual Production by Publication More Than Two (2) Years Before, Namely on December 23, 1952, Is Barred by the California Two Year Statute of Limitations, California Code of Civil Procedure, Section 339, Subdivision 1, as to Each and All Purported Causes of Action.

1. The Decision in This Case Must Be Governed by the Law of California as Interpreted by Its Courts, and by No Other Law.

A complaint may be dismissed on motion under Federal Rules 9(f) and 12(b)(6) for failure to state a claim upon which relief may be granted where it appears on the face of the complaint that the alleged claim is barred by the statute of limitations.

Suckow Borax Mines Consolidated, Inc. v. Borax Consolidated, Ltd., 185 F. 2d 196, 204 (9 Cir., 1950), *cert. den.*, 340 U. S. 943, 71 S. Ct. 506, 95 L. Ed. 680, *rehear. den.*, 351 U. S. 912, 71 S. Ct. 620, 95 L. Ed. 1349 (1951).

Since the jurisdiction of the court below is based upon diversity of citizenship, the applicable statute of limitations is the statute of limitations of the State in which the United States District Court is located, in this case—California.

Van Dyke v. Parker, 83 F. 2d 35 (9 Cir., 1936).

The rule applies equally in diversity cases whether the action is considered one at law or in equity.

Guaranty Trust Co. v. York, 326 U. S. 99, 65 S. Ct. 1464, 89 L. Ed. 2079 (1945).

Furthermore the complaint here recites that plaintiff is a resident of California [R. 3]. It is apparent, therefore, that the decision in this case must be governed by the law of California as interpreted by its courts, and by no other law.

2. The California Statutes of Limitations Are Comprehensive and Apply to All Actions, Whether Legal or Equitable, Unless Expressly Excepted.

In California the legislature has expressly provided that

“civil actions, *without exception* can only be commenced within the periods prescribed in this title, after the cause of action shall have accrued, unless where, in special cases, a different relationship is prescribed by statute.” (Emphasis supplied.)

Cal. Code Civ. Proc., Sec. 312.

See

McGuire v. Hibernia Savings & Loan Society,
23 Cal. 2d 719, 733, 146 P. 2d 673, 680 (1944).

Subdivisions 335 to 363 of the California Code of Civil Procedure provide various limitations for all actions other than real property actions. These statutes of limitation thus apply to every conceivable type of legal, equitable, and statutory actions other than real property actions.

McGuire v. Hibernia Savings & Loan Society,
above, 23 Cal. 2d at p. 733, 146 P. 2d at p. 680;

Hartley Pen Co. v. Lindy Pen Co., 16 F. R. D.
149, 158 (S. D. Cal., 1954), and cases cited.

It also is the settled law of California that it is the nature of the right sued upon and not the form of action nor the relief demanded which determines the applicability of the particular California statute of limitations.

McGuire v. Hibernia Savings & Loan Society,
above, 23 Cal. 2d at p. 733, 146 P. 2d at p. 680.

At this point, therefore, we may summarize as follows:

a. This being a diversity case on appeal from a district court sitting in California, the law of California must be looked to for decision. That law provides for comprehensive statutes of limitation applicable to all kinds of actions, legal or equitable, with no exceptions other than exceptions specifically provided for, and this action is not such an exception.

b. It also is the law of California that it is the nature of the cause of action and not the form of the action nor the remedy sought which determines which particular statute of limitations should apply.

3. It Has Been the Settled Law in California for Almost 16 Years That an Action for the Appropriation of an Author's Common Law Intellectual Production and Its Publication by Another Is Barred by the Two-year Statute of Limitations.

Cal. Code Civ. Proc., Sec. 339, Subdivision 1;

Italiani v. Metro-Goldwyn-Mayer Corporation, 45
Cal. App. 2d 464, 114 P. 2d 370 (1941).

The action commences to run from the date of first publication by the appropriator and continuous publication thereafter within the two year period does not remove the bar of the statute.

California Code of Civil Procedure, Section 339, Subdivision 1, provides in pertinent part as follows:

“§339. [Within two years.] Within two years:

“1. An action upon a contract, obligation or *liability not founded upon an instrument of writing*, other than that mentioned in subdivision two of section three hundred thirty-seven of this code; . . .”
(Emphasis supplied.)

The California law on the subject of the applicability of the above statute of limitations to an action for alleged plagiarism of a common law intellectual property is contained in the decision of *Italiani v. Metro-Goldwyn-Mayer Corporation*, above cited. In that case the motion picture producer, Metro-Goldwyn-Mayer Corporation, and the motion picture distributor and exhibitor, Loew's Incorporated, were alleged to have unlawfully appropriated and converted to their own use plaintiff's motion picture scenario and to have distributed and exhibited the scenario in a motion picture photoplay *continuously* within three (3) years preceding the filing of the complaint. [See 45 Cal. App. 2d at p. 465, 114 P. 2d at p. 371, and R. 27-35.] The District Court of Appeal held that an action for the appropriation or theft of incorporeal intellectual production is a tort action (this holding was approved by the Supreme Court of California in *Weitzenkorn v. Lesser*, 40 Cal. 2d 778, 784, 795, 256 P. 2d 947, 953, 959 (1953)), that it is settled law that the word “liability” as used in Code of Civil Procedure, Section 339, Subdivision 1, includes responsibility for torts not specifically mentioned in other statutes of limitation, hence the two year section, Code of Civil Procedure, Section 339, Subdivision 1, applied to an appropriation of an author's common law work.

On page 18 of Appellant's Opening Brief, it is argued that the court in the *Italiani* case failed to consider the question of continuous exhibition. It is submitted that this statement is patently incorrect for the following reasons:

a. The District Court of Appeal specifically quoted in its opinion a portion of the amended complaint reciting *continuous exhibition* within three years preceding filing of the complaint as follows:

“‘that within three years from the filing of the complaint “plaintiff is informed and believes and upon such information and belief alleges that the defendants and each of them, without the knowledge, consent or authority of or from the plaintiff, *and continuously during said time*, did deliberately and unlawfully appropriate and convert to their own use plaintiff's said literary composition and moving picture scenario, and said defendants did, for a profit, reproduce, sell, *distribute and exhibit* the same in a sound and talking motion picture photoplay entitled and designated ‘O'Shaughnessy's Boy.’”’” (Emphasis supplied.) (25 Cal. App. 2d at p. 465, 114 P. 2d at p. 371.)

b. The amended complaint in the *Italiani* case distinctly shows that continuous exhibition by the defendants therein was an integral part of the cause of action [see Par. VII, R. 34, and see Par. VIII, at R. 31 where it is alleged that “defendants continue to release, distribute and exhibit said motion picture photoplay throughout other parts of the world”].

c. The *Italiani* case went up after a demurrer to the amended complaint was sustained without leave to amend, a procedure akin to that at bar. It must be assumed that

the District Court of Appeal considered the allegation of continuous exhibition in reaching its decision. As the Supreme Court of California has said, on such an appeal pleadings "must be read as a whole and each part must be given the meaning that it derives from the context wherein it appears."

Speegle v. Board of Fire Underwriters, 29 Cal. 2d 34, 42, 172 P. 2d 867, 872 (1946).

d. The District Court of Appeal clearly recognized that it was dealing with a common law intellectual property by referring to 13 Corpus Juris, page 948, section 5(a) for a definition of an intellectual production, specifically a scenario. See

Italiani v. Metro-Goldwyn-Mayer Corp., 45 Cal. App. 2d at p. 466, 114 P. 2d at p. 372.

The subsection in Corpus Juris cited deals with the common law right of property in intellectual productions. Furthermore, the plaintiff in the *Italiani* case himself characterized his rights in his scenario as "common law literary rights" [R. 29].

4. An Appropriation of a Common Law Intellectual Work Must Clearly Be Distinguished From Infringement of Statutory Copyright.

This court must not be misled by the phrase "common law copyright". No such copyright exists. The only right to make and vend copies, *i. e.*, true "copyright", exists solely by virtue of statute, namely the Federal Copyright Act, 17 U. S. C. A., Section 1, *et seq.* The statute provides, Title 17 U. S. C. A., Section 101, that every unauthorized copy of a *copyrighted* work or every unauthorized delivery of a *copyrighted* lecture, sermon or address or every unauthorized performance of a *copy-*

righted dramatic or musical composition is an infringement. But the act, by its own terms, is applicable only to infringement of the statutory copyright.

Contrast the common law rights of an author in an unpublished work. The primary right recognized at common law is the right to *first publication* of the work.

Loew's Incorporated v. Superior Court, 18 Cal. 2d 419, 421, 423, 115 P. 2d 983, 984, 985 (1941);

Stanley v. Columbia Broadcasting System, 35 Cal. 2d 653, 661, 221 P. 2d 73, 77-78, 23 A. L. R. 2d 216, 225 (1950).

All other common law rights stem from that right.

Loew's Incorporated v. Superior Court, above, 18 Cal. 2d at p. 422, 115 P. 2d at pp. 984-985;

Stanley v. Columbia Broadcasting System, above.

So, for example, if an author makes a general publication of his work, he loses all his common law rights. Conversely, if he makes only limited publication of the work, he does not lose those rights. These common law rights can be abolished by an exclusive statutory scheme of protection, and such has happened in England.

Sec. 31 (Copyright Act, 1911) 1 and 2 Geo. 5, c. 46.

Unlike the contrary provisions of the English statute, these common law rights expressly were reserved to authors of unpublished works in our Federal copyright statute.

17 U. S. C. A., Sec. 2.

But the common law to be applied here is not the general common law but the common law of California.

And in California an author's common law rights have been codified by the legislature of that state, Civil Code, Sections 980, 983, and the legislature in the past has seen fit to amend the nature of those rights from time to time (see discussion under the publication section of this brief, below).

Therefore, it cannot be doubted that the California legislature, if it chose, could enact a specific statute of limitations to reach the result in the case at bar. It also follows that where a comprehensive scheme of statutes of limitation has been enacted, the same result may follow. This argument is strengthened by the fact that the Supreme Court of California has characterized the intellectual products of an author as *property*, entitled to the same protection as rights in any other species of property,

Loew's Incorporated v. Superior Court, above, 18 Cal. 2d at p. 421, 115 P. 2d at p. 984.

Hence, conversely, rights in this type of property must be subject to the same disabilities as rights in other types of property, for example, an appropriation thereof can be completely barred by a statute of limitations at some point in time—*Italiani* says in two years.

We have seen that at common law the author's primary right is that of first publication. And if he makes *one* general publication of his work, he dedicates the work to the public.

Grandma Moses Properties v. This Week Magazine, 117 Fed. Supp. 348, 350 (S. D. N. Y., 1953).

The rationale of the *Italiani* case appears to be based on the premise that since an author of an unpublished

work has as his primary right that of first publication thereof, that while an unauthorized first publication by another may not be such a publication as will dedicate the work generally to the public, nonetheless it is a publication and hence an appropriation of the work, *i. e.*, the taking amounts to literary theft and is immediately complete as between the author and the appropriator. Thus, despite the fact that the author may retain his rights to damages or an injunction, if he acts in time, against other members of the public who publish the work without permission, and despite the fact that the author still may himself be entitled to statutory copyright if he thereafter registers his work, his rights against this particular appropriator who published the work and those who claim under that appropriator may be barred by the statute of limitations; and they are so barred in California.

On page 23 and again at page 27 of Appellant's Opening Brief, the case of *Cain v. Universal Pictures Corp.*, 47 Fed. Supp. 1013 (S. D. Cal., 1942), is discussed. The *Cain* case involved an infringement of statutory copyright and has no application to the case at bar. There the work infringed by a motion picture was a copyrighted book and, of course, under the Federal copyright statute, as indicated above, every exhibition of a motion picture is a separate infringement. The *Italiani* case was brought into the *Cain* decision solely by reason of the fact that one Taylor, the scenario writer, made a motion to dismiss relying on the California two year statute of limi-

tations on the ground that he had made only *one* infringement, to wit, his copying of the book when he wrote the infringing scenario which infringing scenario he turned over to the motion picture company more than two years prior to the filing of the complaint. Judge Yankwich held that the action as to Taylor was not barred by the statute of limitations because his aim was to participate in subsequent statutory infringements by others.

Cain v. Universal Pictures Corp., above, 47 Fed. Supp. 1013, at p. 1018.

5. The Two-year Statute of Limitations Is a Bar to All the Remaining Purported Causes of Action.

The gist of an action for the taking of an author's common law intellectual property is the appropriation or theft of literary property. This is a tort, and since the author's primary common law right is the right to the first publication of that property, and since the taking is complete when the appropriator himself publishes the property, the result is that unless the author sues within two years, under California law any action against the appropriator is barred and the appropriator and those who claim under him are free to do with the property as they please.

We have seen that it is the substance of the action in California and not the particular form of the prayer for relief that determines the nature of the action. It also is immaterial in applying the statute of limitations whether this case is considered as an action at law or in equity. Whether an author seeks damages, or asks

for an accounting of profits, or for an injunction because of this appropriation, relates simply to the remedy, not to the nature of the action.

Certainly, if this plaintiff cannot maintain a direct action for damages for the *publication and use* of the song by defendants, it must follow that the bar of the statute of limitations cannot be circumvented by the addition of a count alleging unfair competition because of such publication and use.

Furthermore, this is not the normal case of unfair competition based solely on the use of a title, where there is no similarity between the contents of the works.

Jackson v. Universal International Pictures, 36 Cal. 2d 116, 120, 222 P. 2d 433, 435 (1950).

Instead, according to plaintiff, this is an appropriation of his entire song, musical composition and title alike. As to secondary meaning he alleges that the general public has "learned to identify plaintiff's *said song and the title* thereof with plaintiff" [R. 10] (Emphasis supplied). Hence his claim of secondary meaning encompasses the whole song, not just the title. Thus the appropriation must be considered indivisible, and because of the bar of the statute of limitations, defendants must be permitted to use both the body of the song and its title.

Moreover, as the sheet music of the defendants' song, as incorporated into the complaint, shows on its face [R. 24] the lettering of its title "THE SONG FROM MOULIN ROUGE" is more than twice the size of that

of the alternate title "WHERE IS YOUR HEART" which appears below it in parentheses. Accordingly, the public cannot be misled as to source.

Finally, since plaintiff claims it is his song which was appropriated by defendants, and since the title describes the song, defendants should be permitted to use it to describe the same song.

Gotham Music Service, Inc. v. Denton & Haskins Music Pub. Co., 259 N. Y. 86, 181 N. E. 57, 58 (1932);

Cf. Champion Spark Plug Co. v. Sanders, 331 U. S. 125, 67 S. Ct. 1136, 91 L. Ed. 1386 (1947) (Where no showing of palming off, sale of article reconditioned by another under original manufacturer's trade name allowed).

6. **If the Author Cannot Bring an Action Against the First Appropriator, It Follows That He Cannot Bring Any Action Against Others Who Claim Under That Appropriator.**

In this respect we simply advert briefly to the fact that the complaint shows on its face that the only song used by all the defendants is the very song first published in the motion picture on December 23, 1952 [R. 24. See references to the record in the statement of facts at page 4 above].

- B. A Professional Entertainer Who Since 1922 Has Sung and Performed His Song in Night Clubs, Music Halls, Theaters, Hotels and other Places of Amusement or Entertainment in the United States, England, France and Many Other Countries Throughout the World Before Hundreds of Thousands of Persons Constituting the General Public Has Published His Work Under California Law.

In the case at bar, plaintiff alleges:

“That plaintiff is an internationally known producer of musical acts and revues (including a well known musical sketch entitled ‘Moulin Rouge’) and plaintiff is himself a professional entertainer and composer residing in the County of Los Angeles, State of California” [R. 3].

“That during the year 1922, plaintiff originated, created and composed a unique, novel and original song and musical composition, with words and music, entitled ‘WHERE IS YOUR HEART’ . . .” [R. 5-6].

“That plaintiff has sung and performed his said song entitled ‘WHERE IS YOUR HEART’ in night clubs, music halls, theaters, hotels and other places of amusement and entertainment in the United States, England, France, and many other countries throughout the world . . .” [R. 6].

“That by reason of plaintiff’s widespread use, performance and singing of his said original song and musical composition entitled ‘Where Is Your Heart’ for more than thirty years last past, in hotels, night clubs, theatres and places of entertainment throughout the world, thousands of persons in the entertainment industry and hundreds of thousands of persons constituting the general public, have

learned to identify plaintiff's said song and the title thereof with plaintiff, and a secondary meaning has attached thereto by which the entertainment industry generally and the general public has for more than thirty years last past identified the song and musical composition entitled 'Where Is Your Heart' solely with the plaintiff herein" [R. 10].

It is the position of defendants that such performances of his song by a professional entertainer to hundreds of thousands of members of the public in places of entertainment over such a long period of time, namely approximately 33 years, amount to a general publication of the work and a dedication of it to the public.

Whether an author's common law rights in his intellectual work are lost by performance is a much debated question. See

Selvin, *Should Performance Dedicate*, 42 Cal. L. Rev. 40 (1954).

There is a division of authority in the cases, and California is aligned with the jurisdictions upholding the view that performance may dedicate, particularly where the performance is for profit.

Blanc v. Lantz, 27 Copyright Decisions 61, 83 U. S. P. Q. 137 (Superior Court Los Angeles County, 1949, not appealed).

Blanc v. Lantz was an action for alleged infringement of the musical laugh commonly referred to as the "Woody Woodpecker" laugh or song. The trial court sustained defendants' demurrer without leave to amend on the ground that under California law plaintiff had lost whatever rights he had at common law and under California statutes by reason of his public performance of the song

over the radio and the incorporation of it in the soundtrack of a motion picture. In his opinion in *Blanc v. Lantz*, Judge Stevens reasoned that

“ . . . to allow the proprietor to perform his work publicly without loss of the right, *no matter how wide-spread or commercially his performances may extend*, is to permit an exploitation of the idea by way of a perpetual monopoly inconsistent with the public good. Therefore ‘publication’ should be construed to be the same as ‘make public’, as used in Section 983 of the Civil Code, and the owner of an intellectual product who ‘intentionally makes it public,’ *whether by performance or by any other means*, should lose his right to exclusive performance unless he seeks the protection of federal copyright legislation and thereby acquires the limited right to exclusive performance which reflects the public policy of the people of this country through their elected representatives. To hold otherwise would enable the proprietor of the right to have the advantage of retaining a perpetual, though partial, monopoly in his product contrary to the whole policy of the copyright act and the Constitution” (27 Copyright Decisions, at p. 66; 83 U. S. P. Q., at pp. 139-140) (Emphasis supplied).

In reaching that decision he noted that

“ . . . although the editors of such works as *Corpus Juris Secundum* and *American Jurisprudence* state generally that the common law copyright is not lost by performance only, a division of authority exists on this question, and the Supreme Court of California appears to have left this question open in *Loew's Incorporated v. Superior Court*, 18 Cal. 2d 419 [50 U. S. P. Q. 641, 643]. In that case, the court stated, ‘The duration of the right, apart

from statute, of exclusive representation by the author of an unpublished dramatic work is not entirely clear. It has been said that it is not lost by public performance. *Ferris v. Frohman*, 223 U. S. 424, 32 Sup. Ct. 263, 56 L. Ed. 492; *Nutt v. National Institute, Inc.*, 31 F. 2d 236, 238. It has also been stated that by a public performance or a publication of the work with the author's consent, the author's common law right to exclusive performance is lost. *Palmer v. DeWitt*, 47 N. Y. 532, 542, 7 Am. Rep. 480; *Keene v. Wheatley*, 14 Fed. Cas. 180, 201, Case No. 7644. See, also, Civil Code, Sec. 983.' The citation of Civil Code, Section 983 following the statement that the common law right may be lost by public performance is some indication that the Supreme Court may have considered that this Section supports that rule." (27 Copyright Decisions at p. 65; 83 U. S. P. Q. at p. 139.)

Section 983 of the Civil Code to which the learned Judge referred was the section as it existed prior to the amendment in 1947. It then read as follows:

"§983. *Effect of publication.* If the owner of a product of the mind intentionally *makes it public*, a copy or reproduction may be made public by any person, without responsibility to the owner, so far as the law of this state is concerned." (Emphasis supplied.)

It now reads in pertinent part as follows:

"§983. [Effect of publication.] (a) If the owner of a composition in letters or art *publishes* it the same may be used in any manner by any person, without responsibility to the owner, insofar as the law of this State is concerned." (Emphasis supplied.)

The change in the statute as it then stood and as it now reads, so far as the question of publication is concerned, lies in the use of the words “makes it public” in the former and the word “publishes” in the latter. Mr. Selvin, at page 50 of his law review article above cited, comments upon the amendment in this language:

“In cases arising under section 983 as it stood down to 1947, there can be little doubt that a public, unrestricted performance or representation of an otherwise unpublished work, effected a dedication. Precisely to that effect is a well-considered opinion of Judge Stevens in *Blanc v. Lantz*, a reported decision of the Los Angeles Superior Court; and the intimations are strong in *Loew's Inc. v. Superior Court*, *Stanley v. Columbia Broadcasting System*, and the *Kurlan* and *Weitzenkorn* cases decided only a few months ago, that this would be the result. Certainly, the language of the statute leaves little room for argument to the contrary. In 1947, however, the section, along with others, was recast * * *. The effect of that change has yet to be determined. In a recent concurring opinion, Mr. Justice Traynor has indicated his view that the 1947 changes were designed only to make it clear that the property right in literary property depended on whether or not it had been published; not on whether the tangible embodiment of the work remained in the author's possession, and that it did not otherwise change the meaning of the sections. [Citing *Kurlan v. Columbia Broadcasting System*, 40 Cal. 2d 799, 875, 256 P. 2d 962, 973 (1953).] It may be, however, that the answer to our question will depend upon the meaning to be given the word ‘publish.’ Does it mean the same as ‘intentionally make public’ or was it designed to confine the situation to ‘publish’ in the narrow sense of ‘reproduction of copies?’ Cases in other

jurisdictions will lend support to either view, with I should say a substantial majority in favor of the view that in copyright law 'publish' means 'make public' or 'communicate to the public.' ”

In *Marx v. United States*, 96 F. 2d 204, 206 (9 Cir., 1938), this court held that a radio performance was a publication, saying:

“The word ‘publication’ has no definite and fixed meaning. ‘The word is legally very old, and of no one certain meaning. * * * The thought, however, running through all the uses of the word, is an advising of the public, a making known of something to them for a purpose.’ ”

Cf. White v. Kimmel, 193 F. 2d 744, 746-747 (9 Cir., 1952).

See also:

Egner v. E. C. Schirmer Music Co., 48 Fed. Supp. 187 (D. C. Mass., 1942), affirmed, *Id.*, 139 F. 2d 398 (1 Cir., 1943).

While the Court of Appeals in the *Egner* case did not discuss the point and affirmed the judgment below on other grounds, the District Court held that the widespread singing by soldiers and others of the composer's common law work “The Caisson Song,” which is familiarly known to us all as “The Caissons Go Rolling Along,” dedicated the work to the public. Judge Sweeney said:

“I find that the use of the song by Sousa and by the soldiers in the various cantonments was not such a limited publication as would save the rights of the composer.” (48 Fed. Supp. at p. 190.)

In other words, Judge Sweeney felt that in a case where an author's unpublished common law musical composition

had become known to the public through performance and where the public had taken up the song and popularized it, although without the composer's permission, such amounted to a dedication despite the traditional view that only a publication by the author could amount to a dedication.

In *RCA Mfg. Co., Inc. v. Whiteman*, 114 F. 2d 86 (2 Cir., 1940), *cert. denied*, 311 U. S. 712, 61 S. Ct. 393, 85 L. Ed. 463 (1940), Judge Learned Hand held that an author of an unpublished musical composition dedicated the work to the public when he *sold* records of the work—this despite the fact that each record contained a restriction on the label against a use of it for profit by the *buyer*. The contention there made was that the recording simply was a performance, was no more than a limited publication, and hence could not dedicate the work.

To the same effect see:

Shapiro, Bernstein & Co., Inc. v. Miracle Record Co., Inc., 91 Fed. Supp. 473, 475 (N. D. Ill., 1950),

where Judge Igou stated:

“It seems to me that publication is a practical question . . .”

Thus far we have seen that in California at least one case, *Blanc v. Lantz*, has squarely held that public performance over the radio for his own gain by an author of an unpublished work, is a dedication. The opinion is extremely well reasoned and complete and reaches its conclusion only after a full consideration of policy reasons, which defendants in the case at bar assert apply with equal force to the instant case and compel a similiar

result. The court in the *Blanc* case found support for its position in an intimation in the opinion of Justice Shenk in *Loew's Incorporated v. Superior Court*, 18 Cal. 2d 419, 423, 115 P. 2d 983, 985 (1941), where the Justice cited Civil Code, Section 983, in conjunction with authorities stating that an author's common law right to exclusive performance is lost by a public performance.

Defendants' view that in California a public performance for profit is a dedication is buttressed by the language of the Supreme Court in *Stanley v. Columbia Broadcasting System*, 35 Cal. 2d 653, 666, 221 P. 2d 73, 80 (1950). There a writer recovered against a broadcasting company on an implied agreement to pay him for an uncopyrighted radio program originated by him, the form and idea of which later was used by the company. The writer's program had been auditioned on one occasion only before a "live" studio audience in the broadcasting company's studio and a recording of the program made. However, neither the program nor the recording was broadcast, nor was the writer paid. The court significantly said, in holding the publication a limited one:

"Defendant's contention that there can be no liability to pay for an idea which has been made public is without merit when *the facts of this case* are considered. When plaintiff made his audition recording before an audience in the National Broadcasting Company's studio he was not making his idea 'public property' within the meaning of the law. Prior to publication an author may make copies of his production and enjoy the benefit of limited or restricted publication without forfeiture of the right of a general publication. The communication of the contents of a work under restriction, known as a 'restricted

or limited' publication, is illustrated by performances of a dramatic or musical composition before a *select* audience. . . ." (Emphasis supplied.)

Under the facts of the case at bar, there was no "limited" publication before a "select" audience. Plaintiff admittedly has performed the song for profit over the years indiscriminately in night clubs, music halls, theatres, hotels and other places of amusement and entertainment in the United States and throughout the world, and "hundreds of thousands of persons constituting the general public" have learned to identify plaintiff's song [R. 10].

In this connection, it must be emphasized that there is no showing or claim of access in the traditional sense here, as contrasted, for example, with the situation in the *Stanley* case, above. Instead, defendant's knowledge of plaintiff's song merely is said to be the result of plaintiff's aforementioned widespread public performances [R. 6]. The cases cited by Justice Shenk in *Loew's Incorporated v. Superior Court*, above, for the proposition that public performance dedicates, indicate that an auditor of a public performance may reproduce it from memory and thereafter use it.

Keene v. Wheatley, 14 Fed. Cas. 180, 192, 201;
No. 7644 (C. C. E. D. Pa., 1861)

("A recitation or lecture before a select audience is private and before an indiscriminate audience, public." ". . . her own previous public performance of the play . . . was, on her part, an act of general publication.");

Palmer v. DeWitt, 47 N. Y. 532, 541-542, 7 Am. Rep. 480 (1872).

See also, the English view expressed in *Caird v. Sime*, 12 App. Cas. 326, 328 (1887) (university professor's lectures to students held no publication because students were selected, controlled audience and general public excluded. Lord Halsbury stating, however,

" . . . where a person speaks a speech to which all the world is invited, either expressly or impliedly, to listen, or preaches a sermon in a church, the doors of which are thrown open to all mankind, the mode and manner of publication negative, as it appears to me, any limitation.")

In summary, at one end of the performance spectrum we have the cases holding that performance is not a publication when the audience is carefully controlled, selected, or invited, the general public is excluded, and the profit motive is minimal or nonexistent.

Caird v. Sime, above (lecture);

Stanley v. Columbia Broadcasting Company (studio audience for audition).

In the middle we have the more difficult cases such as the play performances. Here the profit motive is present, and the courts strain to find some control of the audience because the latter must purchase tickets, the court sometimes finding in this fact an implied contract not to disclose or use what is heard. Typical of these cases are

Ferris v. Frohman, 223 U. S. 424, 32 S. Ct. 263, 56 L. Ed. 492 (1912);

Tompkins v. Halleck, 133 Mass. 32, 43 Am. Rep. 480 (1882).

It is submitted that *Keene v. Wheatley*, above, represents the view more consonant with public policy, and that it must be borne in mind that *Ferris* and *Tompkins* were

decided on facts occurring before the enactment of the Federal Copyright Act of 1909, which for the first time in this country, secured copyright for manuscripts not reproduced for sale.

At the other end of the performance spectrum we have such cases as *Blanc v. Lantz*, above (radio broadcast), and the *instant case* (performance indiscriminately in night clubs, music halls, theatres, hotels and other places of amusement and entertainment). A close analysis of the cases dealing with the problem of whether performance is a publication will demonstrate that there has never been a hard and fast rule that no performance can be a publication, the courts never having said more than that *under the facts of the particular case* performance was not a publication.

It is respectfully asserted, therefore, that under the law of California, both before and after 1947, a public performance of an unpublished dramatic or musical work for profit is a dedication, and in the language of the statute:

“ . . . the same may be used in any manner by any person, without responsibility to the owner, insofar as the law of this State is concerned.”

Certain it is that during the period 1922-1947, plaintiff already had dedicated his composition.

If ever there was a case where long continued public performance for profit throughout the world resulted in loss of “possession” and making “public” as those terms are used by the California statutes, the case at bar is such a case.

Conclusion.

This case really turns on what the basic policy underlying the so-called "perpetual" common law "copyright" shall be, as that policy is interpreted by the California Courts. That policy is to adhere strictly to the mandate found in the United States Constitution, Article 1, Section 8, granting Congress the power "To promote the Progress of Science and Useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." Thus where an author does not choose to avail himself of the Federal Copyright Act, which includes among its provisions one for copyright of an unpublished work of which copies are not reproduced for sale (17 U. S. C. A., Sec. 11), he must act in time—in California, within two years—if another appropriates his work, or his action for such taking is forever barred.

We conclude by appropriating the language of Judge Stephens in *Blanc v. Lantz*, above. Here then we are confronted with a situation where, for the purpose of this motion, the plaintiff had created a musical composition which he could have copyrighted under federal law and thereby have secured a limited monopoly to the exclusive performance of his intellectual product. By failure so to protect his work, yet by electing to exploit it commercially by personal performance, plaintiff has lost his right to the exclusive property in the song. Since defendants' asserted acts of plagiarism occurred subsequent to the acts

by which plaintiff “published” his creation, they are under no liability to plaintiff for its use. (See 27 Copyright Decisions, pp. 71-72; 83 U. S. P. Q. at p. 142.)

The judgment should be affirmed.

Respectfully submitted,

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